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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,164	11/22/2003	William R. Graves	480927.00002	2344

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EXAMINER

HAAS, WENDY C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,164

Applicant(s)

GRAVES ET AL.

Examiner

Wendy C Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

New corrected drawings are required in this application because the drawings are improperly mounted on paper. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to

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the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as “Annotated Marked-up Drawings” and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the “Notice of Allowability.” Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Arrangement of the Specification

The appropriate format for the arrangement of a Plant Patent Specification is set forth in 37 C.F.R. § 1.163(c) which states:

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(c) The specification should include the following sections in order:

- (1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.*
- (2) Cross-reference to related applications (unless included in the application data sheet).*
- (3) Statement regarding federally sponsored research or development.*
- (4) Latin name of the genus and species of the plant claimed.*
- (5) Variety denomination.*
- (6) Background of the invention.*
- (7) Brief summary of the invention.*
- (8) Brief description of the drawing.*
- (9) Detailed botanical description.*
- (10) A single claim.*
- (11) Abstract of the disclosure.*

The arrangement proscribed in the Rules is preferred in framing the specification and, except for the title of the invention, each of the numbered items should be preceded by the headings indicated below (in **BOLD CAPITAL LETTERS**) as tailored for application for a plant filed under 35 USC 161:

- (1) ***Title of the Invention:*** The title of the invention should be placed at the top of the first page of the specification. The title of the invention must include the name of the claimed plant. The name of the plant is to be used for international recognition and identification of the plant, and must fall within the requirements of the International Code of Nomenclature for Cultivated Plants, 1980. The name of the plant must be placed between two single quotation marks to indicate which word in the title is the plant name.

(2) ***Cross-References to Related Applications:*** (If any.) Related applications include:

- (1) A utility application from which the claimed plant is the subject of a divisional application.
- (2) A continuation (copending, newly filed application) to the same plant filed when a parent application has not been passed to issue.
- (3) An application not copending with an original application which was not allowed.
- (4) Copending applications to siblings or similar plants developed by the same breeding program, etc.

(3) ***Statement Regarding Federally Sponsored Research and Development:*** (If any.)

See MPEP § 310.

(4) ***Latin Name of the genus and species of the plant claimed.*** This should be placed under a separate heading titled – **BOTANICAL DESIGNATION** --.

(5) ***Variety Denomination.*** This is the cultivar name. It should be placed beneath a new heading, -- **VARIETY DENOMINATION** – and should be placed inside single quotation marks.

(6) ***Background of the Invention:*** The specification may set forth the Background of the Invention in two parts:

- (1) **Field of the Invention:** The field of the invention is intended to identify the botanical and market class of the invention, and to reflect how the plant will be used. This section should indicate the botanical name of the plant by genus and species, and should state the market class of the plant.
- (2) **Description of the Related Art:** Here, the parents of the claimed plant, or the known plants to which the claimed plant is related are discussed. Frequently the parent plant or plants are identified in this section and are described as to their most important or distinguishing characteristics. The claimed plant may be compared to the parent plant or plants in this section. If the parent plants are not known, the probably parent plants may be indicated. It is appropriate in this section to indicate how the plant was attained and to detail the necessary averments to how and where the plant has been asexually reproduced. This section must also include a positive statement that the claimed plant originated as a SINGLE plant and that clones or propagules of the claimed plant are identical to the original plant in all distinguishing characteristics so as to establish that the claimed plant is stable.
- (7) ***Summary of the Invention:*** In the Summary section, the major characteristics of the plant are set forth, and they may be presented as a list of novel characteristics,

or by a narrative description of the trait or traits of the plant which set the plant apart from all other plants of the botanical class and market class of the fruit. The plant should be compared to any parent cultivars, if known and to the most similar plant(s) in its market class known to the inventor(s).

- (8) ***Brief Description of the Drawing(s):*** Under this heading a separate brief description should be presented to describe the contents of each view of the figure of the drawing. The drawing in a plant patent must be prepared to show the plant with the most distinguishing characteristics of the plant in sufficient scale to be identifiable when reduced by as much as 50%. Drawings should be photographic, and must be in color. Where characteristics of foliage, bark, flowers and/or fruit are distinguishing, such plant parts should be clearly depicted in one or more figures of drawing. Figures of the drawing need not be numbered unless specifically required by the examiner. The drawing must be printed on photographic paper meeting the size requirements of 37 CFR 1.84.
- (9) ***Botanical Description of the Plant:*** This section should be a complete botanical description of the claimed plant. Specification of the genus, species and market class may begin this section, and the parents of the claimed plant may be specified in the initial part of this section. The growth habit of the plant should be described as to the shape of the plant at maturity, and branching habit. The characteristics of the plant in winter dormancy should be completely described, if

appropriate. A complete botanical description of bark, buds, blossoms, leaves and fruit should be a part of the disclosure. Plant qualities which are not capable of definitive, written description or which cannot be clearly shown must be substantive attention in this portion of the application. These would include, but not be limited to fragrance, taste, disease resistances, productivity, precocity, and vigor. Even if the characteristics are well depicted, the botanical characteristics must be substantively describe. The descriptions in this sections should be botanical in nature and should be in terms of the art of the plant. The detail of this section should be sufficient to prevent others from attempting to patent the same plant at a later date by simply describing the plant in more detail and with the allegation that the original patent did not state the characteristics being further described.

- (10) **Claim.** The claim must commence on separate sheet. (37 CFR 1.52(b)). A plant patent is limited to one claim. The claim shall be in formal terms to the plant as shown and described, as the claim is regarded as being drawn to the plant as a whole. The claim may also make reference to one or more of the unusual characteristics of the plant, but may not claim parts or products of the plant. The claim must be in single sentence form. The preferred claim is: – A new and distinct variety of [*Genus species*] plant, as hereby described and illustrated. --.

- (11) ***Abstract of the Disclosure:*** The abstract is a brief description of the plant and of the most notable or novel and important characteristics of the claimed plant. Preferably, the description of the plant will be a condensed review or presentation of the most distinguishing characteristics of the plant.

If applicants continue to prosecute the application, revision of the specification and claims to present the application in proper form is required.

A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the number and nature of amendments that must be made in order to satisfy the rejections and objections set forth in this Office Action would make a specification amended by other means confusing and difficult to consider.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

Claim Objections

The claim is objected to because it is improper. Specifically, the claim must be to a PLANT. See 35 U.S.C. § 162.

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited.

The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the

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plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Applicant's amendment of December 23, 2003 should be changed so that the heading reads: **--STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH AND DEVELOPMENT--**.

B. Applicant must insert a Botanical Designation and Variety Denomination for the claimed plant into the specification in the appropriate location in order to comply with **37 C.F.R. §§ 1.163(c)(4) and (5)**.

C. Applicant is advised to consult the examples of Plant Patents provided by the Examiner for indications of proper format and needed information for the instant application.

D. The "Drawing Figures" description is located in the wrong place in the Specification. Correction is needed.

E. Applicants should change each instance of the word "Fig." to read: **--FIG--**. As the drawing sheets of record are not so labeled, it is inappropriate to refer to the drawing as "Fig." in the specification. In the alternative applicant could label the required amended drawing sheets to recite "Fig.". In any event, the specification and drawings must correspond to each other in this regard.

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F. The description of the illustration “FIG 1” set forth in the specification does not appear to correspond to the photograph provided. Specifically, the specification described the photograph as “an illustration of the habit of the typical seaside alder”, while the photograph shows numerous plants. Correction is needed. A similar problem exists with “FIG 2”, which also seems to illustrate multiple plants.

G. The word “catkin” in the description of “FIG 3” should be made plural, for accuracy.

H. Applicants should refer to cultivar names within single quotation marks throughout the Specification, Abstract and Claim, as this is the convention employed by the International Code of Botanical Nomenclature.

I. Applicants must specify that the claimed plant originated as a single plant, if accurate, in order for the cultivar to qualify as statutory subject matter under 35 U.S.C. § 161.

J. Page 2, line 12, applicant should insert the phrase – known to the inventors – after the word “alders”. United States Plant Patent Applications must be accurate, and it is not possible for Applicants to have full knowledge of the characteristics of possible future cultivars that may arise during the enforceable term of any patent that may grant on the instant application.

K. Page 2, lines 22-23, it is unclear what applicant intends by the term “infrutescences”. Clarification is required.

L. Applicant's description of the claimed plant in paragraph [0009] is overly laudatory, potentially inaccurate as portrayed and must be corrected.

M. Applicants are requested to disclose whether the comparison cultivars 'Blue River #6', 'Pennington #5' and 'Pennington #6' have been patented in the United States, are currently the subjects of pending United States Plant Patent Applications, or are unpatented. If patented, -- (United States Plant Patent Number)-- should be inserted after the appropriate cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name, or such could simply be acknowledged in Applicants' next response.

N. Applicants must provide color designations with reference to the employed color chart for the following botanical structures of the claimed plant: Trunk, branches, petioles, stipules (upper and lower surface, if any), upper and lower leaf veins, lower side of mature leaf, colors of fall foliage variegation, new branch growth, roots, and a complete description of the catkin coloration (multiple colors are illustrated) as well as the peduncles of the catkin. As the claimed plant is monoecious, the male and female catkins must be separately described. More information is required.

O. Pages 2-3: Applicants appear to describe the species in general rather than the claimed plant. Applicant must provide a detailed description of the specific plant claimed. The description must state the age of the plant described and its location of culture as well as the time

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of year the plant was observed and the specific cultural conditions (i.e. light, temperature, water, etc.) the plant was grown under. The description should include, but is not limited to:

- Root size, shape, color
- Plant height and diameter
- Trunk color, texture, diameter at a given height from the ground
- Approximate number of branches
- Branch color, length, diameter and internode distance
- Petiole color, length and diameter
- Leaf color, venation, shape, margin shape, apex shape, base shape, texture, length, diameter
- Number of catkins (male and female)
- Catkin shape, colors, number of flowers per inflorescence, pollen produced, time and length of bloom
- Pedicel length, diameter, color
- Fruit/seed number, shape, color, viability
- Disease resistance
- Heat/Cold/Salt tolerance

P. The claim is improper. A new claim is suggested: -- A new and distinct variety of Seaside Alder plant named 'September Sun', as herein illustrated and described.--.

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The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the drawings.

References Cited

The references cited on the attached PTO-892 are made of record to show the state of the art.

Future Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 7:00 to 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT. 1661